Remarks

This communication is considered fully responsive to the third Office Action mailed January 31, 2005. Applicant appreciates the examiner removing the finality of this Office Action.

In the third Office Action, Claims 1, 4-12, and 14-27 were examined. Claims 1, 4-12, and 14-27 stand rejected. Independent claims 1, and 12 are amended. Dependent claims 5-7 and 11 are amended consistent with amendments to corresponding independent claim 1. Dependent claims 16-17 are amended consistent with amendments to corresponding independent claim 12. No new matter is presented by the amendments. Claims 2, 3, and 13 were previously canceled. No new claims have been added. Reexamination and reconsideration of claims 1, 4-12, and 14-27 are respectfully requested.

Telephone Interview

Applicant appreciates the telephone interview afforded the undersigned attorney, Mark Trenner, on April 11, 2005, with the examiner and the primary examiner, Shahid Alam. Mr. Trenner proposed an amendment substantially as shown in the above Listing of Claims. The examiner said that he would need to reconsider the amended claims in view of the references before he could indicate whether Applicant's claims would be allowable, and requested that Mr. Trenner file a formal Response and Amendment.

As noted in the examiner's Interview Summary mailed on April 14, 2005, Mr. Alam also raised the possibility of Section 101 and 112 issues during the telephone interview. Applicant has considered Mr. Alam's remarks,

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however, Applicant already addressed the Section 112 rejections and does not believe there is any basis for a Section 101 rejection.

Claim Rejections - 35 U.S.C. 112

The Section 112 rejections from the second Office Action were not repeated in the third Office Action, however, these rejections were not expressly withdrawn. Applicant respectfully requests that the Section 112 rejections be expressly withdrawn for the reasons stated in Applicant's Response to the second Office Action filed on January 7, 2005.

Claim Rejections - 35 U.S.C. 103(a)

The third Office Action (hereinafter referred to as "the Office Action) maintained the rejection of claims 1, 4-12, and 14-27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,557,907 to Czyszczewki, et al. (hereinafter referred to as "Czyszczewki") in view of U.S. Patent No. 6,321,308 to Arnon, et al. (hereinafter referred to as "Arnon"). Applicant respectfully traverses this rejection.

Amended claim 1 positively recites "identifying said user-specified remote storage device having said electronic document based at least in part on a path thereto specified by a user at said multifunction device" and "sending said electronic document from said multifunction device." The cited references fail to teach or suggest at least these recitations.

The Office Action cites to Czyszczewski at col. 3, lines 50-55, which states:

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". . . the multifunction device can access remote datastores to obtain user-specific information, such as user profile and user security information, and can then utilize this user-specific information with various functions of the system, including keystroke saving functions, limitation of access rights, and accounting information."

Although this citation discloses the multifunction device accessing remote datastores (e.g., to obtain a user profile), there is no teaching of <u>a user-specified remote storage device</u>. Nor is there any teaching of accessing an electronic document at a user-specified remote storage device and <u>sending the electronic document from the multifunction device</u>.

The Office Action also cites to Czyszczewski at col. 7, lines 26-30, which states in part:

". . . the multifunction device 10 can provide a capability for the user to select as a destination, for example, the printer 43n connected to another controller 25n, and to then instruct the system to hold the document, that is, to refrain from printing it, until the user requests that the document be printed."

This citation teaches <u>selecting a destination</u> for a document (e.g., a printer). However, there is no teaching of accessing an electronic document at a user-specified remote storage device.

The Office Action also cites to Czyszczewski at col. 10, lines 21-27, which states:

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> *"Using the multifunction device 10 with an internal set of functions, such as fax, copy and e-mail, the teachings herein provide access to data and provide a user with an ability to use all available functions from the touch screen display 40. For example, the user can retrieve a document from a remote datastore 150 and fax, e-mail or print it on a selected device. This information is dynamic."*

Although this citation discloses retrieving a document from a remote datastore 150, there is no teaching of a user-specified remote storage device. To the contrary, Czyszczewski goes on to clarify how the user can retrieve a document from a predetermined remote datastore, e.g., at col. 10, lines 49-56:

> *Assume that a corporation's human resource documents are stored on a website . . . . Using the multifunction system 10 one can access the website and have the latest, most up-to-date versions of these documents printed, faxed or e-mailed on demand."* [Emphasis added].

Here, Czyszczewski explains that the user can retrieve a document from a predetermined location (i.e., a website where the human resource documents are stored). Again, there is no teaching of identifying a user-specified remote storage device based at least in part on a path specified by a user.

Czyszczewski gives another example of how the user can retrieve a document from a remote datastore, e.g., at col. 11, lines 20-21:

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"The teachings herein provide the ability to connect to <u>the</u> <u>corporate directory</u> and make it accessible to the multifunction device. " [Emphasis added].

Again, Czyszczewski explains that the remote datastore is <u>predetermined</u> (i.e., the corporate directory).

Czyszczewski gives yet another example of how the user can retrieve a document from a remote datastore, e.g., at col. 11, lines 1-12:

"As another example, assume that a company wishes to enable secure printing. Through the network connectivity of the multifunction device 10, documents can be accepted from remote users. Then when the user is at a local device, they can identify themselves to the system via a secure method . . . . The validated user is then provided access to all documents waiting for him or her, and can print, fax, and/or e-mail from the multifunction device 10. "

This citation teaches against "identifying said user-specified remote storage device having said electronic document based at least in part on <u>a path</u> <u>thereto specified by a user at said multifunction device</u>," by requiring the user to first upload documents to the multifunction device and then go through a security protocol at the multifunction device to access the documents already uploaded to the multifunction device.

The Office Action further relies on Arnon (col. 4, lines 60-66) as teaching these recitations. This passage in Arnon discloses a record having a data portion with "an identifier identifying the target device (disk) and

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requesting device (controller) . . . ." However, there is no disclosure of identifying a user-specified remote storage device based at least in part on a path specified by a user at a multifunction device. Indeed, there is no teaching or suggestion in Arnon that the user has anything at all to do with identifying the target device.

Even combining Arnon and Czyszczewki would result in a multifunction device coupled to a remote storage system for maintaining a mirror copy of data stored at the multifunction device. Again, the proposed combination fails to suggest the properties and results of the claimed invention and does not suggest the claimed combination as a solution to the problem which the claimed invention solves. In re Wright, 6 USPQ2d 1959 (Fed. Cir. 1988) (restricted on other grounds by In re Dillon, 16 USPQ2d 1897 (Fed. Cir. 1990)).

For at least the foregoing reasons claim 1 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 4-11 depend from claim 1, which is believed to be allowable. Therefore, claims 4-11 are also believed to be allowable for at least the same reasons as claim 1 and withdrawal of the rejection of claims 4-11 is respectfully requested.

Claim 5 positively recites "combining said document in electronic format with said electronic document from said user-specified remote storage device." The cited references fail to teach or suggest at least these recitations.

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The Office Action relies on Czyszczewski at col. 9, lines 3-7, which states:

> *"Step F takes the input data from Step E and adds it to the buffer of a thread that is communicating with the desired output device. The data can be added to a linked list of buffer data contained within the thread for shipment to the output device."*

This citation discusses adding data to a communications buffer. However, there is no teaching or suggestion that an electronic document from the user-specified remote storage device is combined with a document converted to electronic format at the multifunction device. The Office Action is impermissibly using hindsight to read more into the Czyszczewski reference than is actually taught. For at least these reasons, claim 5 is believed to be allowable.

Claim 6 positively recites "combining said electronic document from said user-specified remote storage device with an electronic document generated at said multifunction device." The cited references fail to teach or suggest at least these recitations.

The Office Action relies on Czyszczewski at col. 11, lines 12-19, which states in part:

> *". . . the user's name and other employee or personal information can be appended to any outgoing documents automatically . . . ."*

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This citation discusses combining a user name or personal information to outgoing documents, but does not disclose combining the electronic document from the user-specified remote storage device with an electronic document generated at said multifunction device. For at least these reasons, claim 6 is believed to be allowable.

Amended claim 12 positively recites "identifying a remote storage device having <u>a user-requested document</u> based at least in part on <u>a path for said remote storage device specified by a user at said configured multifunction device</u>." Again, the Office Action relies on Czyszczewski at col. 3 (lines 50-55), col. 7 (lines 26-30), and col. 10 (lines 21-27). As discussed in detail above for claim 1, these citations do not teach or suggest at least the recitations of claim 12.

For at least the foregoing reasons claim 12 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 12.

Claims 14-20 depend from claim 12, which is believed to be allowable. Therefore, claims 14-20 are also believed to be allowable for at least the same reasons as claim 12 and withdrawal of the rejection of claims 14-20 is respectfully requested.

Claim 15 is also believed to be allowable for at least the same reasons as discussed above for claim 5.

Claim 16 is also believed to be allowable for at least the same reasons as discussed above for claim 6.

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Claim 21 positively recites "including program code for identifying data operatively associated with <u>a user-specified remote storage device</u>; and program code for accessing said data operatively associated with <u>said user-specified remote storage device</u> from said multifunction device" (emphasis added). The cited references fail to teach or suggest at least these recitations.

The Office Action relies on Czyszczewski at col. 9, lines 38-49, which states:

> "*<u>The corporate security database 180</u> provides the system with user identification data to verify the identity and access privileges of a particular user. The information can include a particular user's employee number, databases that the user is authorized to access, etc. <u>The corporate directory database 185</u> can include user profiles, for example, a user's contact information, telephone number, fax number and e-mail address may be stored in the corporate directory database 185. A user may also store a particular fax cover sheet, or cover sheet information in <u>the corporate directory database 185</u> for automatic retrieval by the controller 25.*" [Emphasis added]

This citation instead supports Applicant's position that Czyszczewski implements a predetermined remote datastore (i.e., "the corporate directory database"). In this example, Czyszczewski requires the user to store documents (e.g., a particular fax cover sheet) in the corporate directory database for automatic retrieval by the controller. If the user were allowed to specify a

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remote storage device there would be no need to first store documents in the corporate directory database before accessing those documents at the multifunction device.

The Office Action also relies on Czyszczewski at col. 10, lines 21-27 as teaching these recitations. However, Czyszczewski's further description (e.g., at col. 10, lines 49-56; col. 11, lines 1-12 and 20-21 discussed above for claim 1) clarifies that the remote datastore is predetermined and not user-specified.

The Office Action further relies on Amon at col. 4, lines 60-66 as teaching these recitations. As discussed in detail above for claim 1, the pointers implemented in Amon's "remote backup" system do not teach or suggest these recitations in Applicant's claim 21.

For at least the foregoing reasons claim 21 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 21.

Claims 22-27 depend from claim 21, which is believed to be allowable. Therefore, claims 22-27 are also believed to be allowable for at least the same reasons as claim 21 and withdrawal of the rejection of claims 22-27 is respectfully requested.

Claim 26 is also believed to be allowable for at least the same reasons as discussed above for claim 5.

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Conclusion

The Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

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